Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
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Ex parte PAUL J. GIORGIO and STEPHEN J. AMURO
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Appeal No. 97-1206
Application No. 08/219,555[1]
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ON BRIEF
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Before HAIRSTON, JERRY SMITH, and BARRY, Administrative Patent
Judges.

BARRY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134

from the patent examiner's final rejection of claims 1 through

5, all the claims pending in the application. The appellants

filed an amendment after final rejection on January 29, 1996.

The examiner denied entry thereof.

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[1] Application for patent filed March 29, 1994.

Appeal No. 97-1206
Application No. 08/219,555

      We REVERSE.

BACKGROUND

The appellant's invention is a method of operating a

controller as a network file server. The controller

interfaces a plurality of host processors to a plurality of

Small Computer System Interface (SCSI) peripheral devices,

i.e., SCSI targets, via a single SCSI initiator within the

controller. When a host processor requests status data, i.e.,

ATTENTION DATA, from a target the data are written to a memory

in the controller from which the processor can read the

requested data. The memory contains separate address spaces

for each of the processors. The requested data are replicated

and a separate copy is stored at each of the address spaces so

that the data are available independently to each of the

processors. Therefore, each of the processors has independent

access to the most currently requested status data.

Claim 1, which is representative of the claims, follows:

1. A method of providing any of a plurality of host
processors ATTENTION DATA and PM DATA on any of a plurality of
SCSI targets through a controller, said controller including a
host adapter, microprocessor, only one SCSI initiator, and
memory, with said memory comprising separate addresses for
ATTENTION DATA from each of said plurality of SCSI targets for
each of said plurality of host processors on a one to one

basis so that ATTENTION DATA from one of said plurality of
SCSI targets for one of said host processors can be cleared
without clearing any other ATTENTION DATA, with said method
comprising the steps of:

    receiving at said controller a command from one of said
plurality of host processors for one of said plurality of SCSI
targets;

    determining if said controller contains ATTENTION DATA
from said one of said plurality of SCSI targets;

    determining if said command is a request for ATTENTION
DATA when said controller contains ATTENTION DATA from said
one of said plurality of SCSI targets;

    returning ATTENTION DATA from said controller to said one
of said plurality of host processors for said one of said
plurality of SCSI targets and clearing at said controller only
the ATTENTION DATA for said one of said plurality of host
processors from said one of said plurality of SCSI targets
when said command is a request for ATTENTION DATA; and

    returning PM DATA for said one of said plurality of SCSI
targets when said controller does not contain ATTENTION DATA
and command is a PM REQUEST.

    The prior art reference of record relied upon by the

examiner in rejecting the appealed claims follows:

Fischer   4,783,730   November 8,

1988

Claims 1-5 stand rejected under 35 U.S.C. § 102(b) as

being anticipated by Fischer. Rather than repeat the

arguments of the appellants or examiner, we make reference to

the appeal brief, reply brief, and examiner's answer for the

respective details thereof.

OPINION

In reaching our decision in this appeal, we have

considered the subject matter on appeal, the rejection

advanced by the examiner, and the evidence of anticipation

relied on by the examiner as support for the rejection. We

have also considered the appellants' arguments contained in

the briefs along with the examiner's rationale in support of

the rejection and arguments in rebuttal contained in the

examiner's answer. After considering the record before us,

it is our view that the Fischer does not meet fully the

invention as recited in claims 1-5. Accordingly, we reverse.

As a preliminary matter, the appellants contends that for

purposes of the appeal the claims do not stand or fall

together. (Brief, p. 5) This contention appears to be based

on enumerated differences in what the claims cover. (*Id.* at

4-5) The appellants fails to present arguments why the

dependent claims (i.e., claims 2-5), which are subject to the

same rejection as the independent claim (i.e., claim 1), are

separately patentable. In the argument section of the appeal

brief the appellants makes no comment on the dependent claims

but only argues about the independent claim. Accordingly, it

is appropriate for us to treat the claims subject to the

rejection as standing or falling together as a single group.

See 37 C.F.R. § 1.192(c)(7); M.P.E.P. § 1206. See In re King,

801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re

Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

        Anticipation is established only when a single prior art

reference discloses, expressly or under the principles of

inherency, each and every element of a claimed invention as

well as disclosing structure which is capable of performing

the recited functional limitations. RCA Corp. v. Applied

Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385,

388 (Fed. Cir. 1984); cert. dismissed, 468 U.S. 1228 (1984);

W.L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d

1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied,

469 U.S. 851 (1984).

     The examiner basically makes a blanket anticipation

rejection of claims 1-5 on Fischer without meaningful

analysis. (Answer, p. 4) The rejection does not indicate how

the examiner is reading the claims on the disclosure of

Fischer. The first time in the answer that the examiner makes

any correspondence between elements of the claims and the

disclosure of Fischer occurs in the response to arguments

section of the answer. There the examiner reads only selected

limitations from the claims on

the disclosure of Fischer. The examiner's correspondence of

elements, however, fails to consider all the language of

claims 1-5.

     Regarding independent claim 1, notwithstanding the many

limitations of the claim ignored by the examiner, the

appellants makes a single relevant argument in support of its

position that Fischer does not anticipate the invention of the

claims. Appellants make several arguments which compare the

disclosure of their invention with Fischer (i.e., arguments

concerning a limitation of an ANSI standard) but the disclosed

invention is not the measure of patentability. The relevant

argument made by appellants are that Fischer fails to

discloses the claimed memory comprising separate address

spaces for storing ATTENTION DATA from each of the targets for

each of the processors on a one-to-one basis such that

ATTENTION DATA from one of the targets for one of the hosts

can be cleared without clearing ATTENTION DATA for any of the

other hosts. (Reply Brief, p. 3) The examiner fails to

address this argument.

       We agree with the appellants that Fischer fails to

disclose the invention of independent claim 1. Fischer

discloses

interfacing a plurality of processors 2 to a plurality of I/O

devices 42a-42c via an I/O adapter 22a and a main memory 26.

Data transferred between the processors and peripheral devices

are written to the memory in the controller (col. 4, lines 14-

20). The memory of Fischer does not replicate data being

transferred from a device, however, and store a separate copy

of the data at separate addresses so that the data are

available independently to each of the processors. The memory

of Fischer employs Queue Descriptors to store data being

transferred between the processors and devices. A single

Queue Descriptor is allocated to each device (col. 5, lines

36-37). Thus, status data from a particular device are not

replicated and stored in separate address spaces for each

processor in Fischer. The status data are stored only at one

address space. Because the invention of claims 1-5 is not

fully disclosed by Fischer, we do not sustain the rejection

based on Fischer.

<u>CONCLUSION</u>

To summarize, the decision of the examiner to reject

claims 1-5 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in

connection with this appeal may be extended under 37 CFR

§ 1.136(a).

<u>REVERSED</u>

KENNETH W. HAIRSTON   )
Administrative Patent Judge   )
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)
)
) BOARD OF PATENT
JERRY SMITH   )   APPEALS
Administrative Patent Judge   )   AND
)   INTERFERENCES
)
)
)
LANCE LEONARD BARRY   )
Administrative Patent Judge   )

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APPEAL NO. 97-1206 - JUDGE BARRY
APPLICATION NO. 08/219,555

APJ BARRY

APJ JERRY SMITH

APJ HAIRSTON

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 11 Jan 00

FINAL TYPED: